



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 45

Date of Decision: 2020-05-22

IN THE MATTER OF AN OPPOSITION

Kim Gibbons Inc.

Opponent

and

Ian Brett

Applicant

1,751,148 for Real Estate Superhero

Application

INTRODUCTION

[1] Kim Gibbons Inc. (the Opponent) opposes registration of the trademark Real Estate Superhero (the Mark), which is the subject of application No. 1,751,148, filed by Ian Brett (the Applicant) on the basis of use of the Mark in Canada in association with the goods and services identified in Schedule A herein (the Goods and Services).

[2] The application claims use of the Mark in Canada “since *at least* January 01, 2006 on goods (1), (3) and on services (1), (2), (3), (4), (6), (7), (9), (10)”; and “since January 01, 2006 on goods (2), (4), (5), (6) and on services (5), (8)”.

[3] For the reasons that follow, I find the application ought to be refused.

THE RECORD

[4] The application was filed on October 19, 2015 and advertised for opposition purposes in the *Trademarks Journal* on November 23, 2016.

[5] On April 19, 2017, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Act was amended on June 17, 2019. All references herein are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended [see section 70 of the Act which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date].

[6] On June 21, 2017, the Applicant, who has been self-represented throughout the opposition proceeding, requested an interlocutory ruling on the sufficiency of the pleadings contained in the statement of opposition and an interlocutory ruling striking the section 30(i) ground of opposition issued on September 8, 2017.

[7] The Opponent's remaining grounds of opposition are summarized below:

- The application does not conform to the requirements of section 30(b) of the Act because the Applicant has actually commenced use of the Mark prior to filing and has not listed the correct date from which it has so used the Mark in association with each of the general classes of goods and services described in the application.
- The Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the Opponent's trademark Mortgage Superhero registered under No. TMA755,473 in association with "[p]rofessional mortgage services and advice to clients as a Mortgage Agent/Broker".
- The Applicant is not the person entitled to registration of the Mark under section 16(1)(a) of the Act because, at the claimed date of first use of the Mark, it was confusing with the Opponent's trademark Mortgage Superhero that had been previously used in Canada in association with "[p]rofessional mortgage services and advice to clients as a Mortgage Agent/Broker".

- The Mark is not distinctive within the meaning of section 2 of the Act, in that it does not actually distinguish, nor is adapted to distinguish, the goods and services in association with which it is allegedly used from the services of the Opponent.

[8] On October 31, 2017, the Applicant filed a counter statement denying each ground of opposition pleaded in the statement of opposition.

[9] As evidence in support of its opposition, the Opponent filed the affidavit of Kim Gibbons, sworn February 26, 2018 (the Gibbons affidavit). Ms. Gibbons was not cross-examined.

[10] As evidence in support of its application, the Applicant filed the affidavits of Amy Mitchell and Ian Brett, both dated May 14, 2018 (hereinafter the Mitchell affidavit and the Brett affidavit respectively). The affiants were not cross-examined.

[11] Both parties filed a written argument. No hearing was held.

ONUS AND MATERIAL DATES

[12] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[13] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a) and 30 of the Act – the filing date of the application, namely, October 19, 2015 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

- Sections 38(2)(b) and 12(1)(d) of the Act– the date of my decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c) and 16 of the Act – date of use claimed in the application, namely, January 1, 2006 [Section 16(1) of the Act]; and
- Sections 38(2)(d) and 2 of the Act – the filing date of the opposition, namely, April 19, 2017 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

OVERVIEW OF THE EVIDENCE

[14] Set out below is an overview of the parties’ evidence, which is discussed in more detail, where appropriate, in my analysis of the grounds of opposition.

The Opponent’s evidence - The Gibbons affidavit

[15] In paragraph 1 of her affidavit, Ms. Gibbons states that she is the founder and director of the Opponent, a corporation incorporated in Ontario on April 12, 2007.

[16] In describing the Opponent’s activities, in paragraphs 3 and 4 of her affidavit, Ms. Gibbons states that:

Through My Company, since August 1, 2007 I have provided professional mortgage services and advice to clients as a mortgage agent / broker under the trademark MORTGAGE SUPERHERO. As the sole owner and director of My Company, I am personally licensed as a mortgage broker under the Financial Services Commission of Ontario (FSCO License #M08001363). All services provided by me personally as a mortgage broker / agent are on behalf of My Company.

As a mortgage broker and mortgage agent, I have access to dozens of lenders, assisting my clients with a variety of mortgage solutions, including home purchases, refinances for debt consolidation, refinances for home renovation and investment, mortgages for the self-employed, investment properties, vacation or home properties, mortgages for those with past or present credit problems, and commercial mortgages. I work very closely with real estate lawyers, as well as real estate agents, real estate brokers, and real estate appraisers. As part of my duties, I often provide client [*sic*] with what is known as a Purview report – which gives an automated valuation of a property based on comparable sales in the area of the subject property.

[17] Regarding the Opponent's promotional and advertising activities, in paragraphs 6 to 8 of her affidavit, Ms. Gibbons states that:

As a result of My Company's work in the mortgage field over the last decade, the MORTGAGE SUPERHERO brand has been featured in various newspapers, magazines, and television programs, including CTV News, Toronto Star, MoneySense, Global News, HGTV, The Globe and Mail, CBC News, The Grid, and the National Post. As a result of My Company's efforts in promoting the MORTGAGE SUPERHERO brand, we have been very successful at driving traffic to our website, and I have been nominated for a real estate industry award for "Best Internet Presence". [...]

My Company is also tremendously active on social media. My Company uses the MORTGAGE SUPERHERO brand on various social media platforms including Facebook, Twitter (joined October 2008 with over 3000 tweets), LinkedIn, Google Plus and YouTube. My Company has also operated a website at *www.mortgagesuperhero.com* which advertises my services as a mortgage agent / broker. The website was launched in 2007 and features a variety of articles on topics such as home renovations, purchasing a new home or condominium, etc. The website prominently features the MORTGAGE SUPERHERO trademark. [...]

I have used to have [*sic*] a wrap on my car for a number of years with the MORTGAGE SUPERHERO trademark featured prominently on the wrap. [...] The purpose of the wrap is to advertise the mortgage broker / agent services of My Company, which are offered under the MORTGAGE SUPERHERO trademark.

[18] Ms. Gibbons provides bulk figures totalling over \$230,000, representing the Opponent's marketing expenses for 2009-2017 and, in paragraph 9 of her affidavit, explains that:

From 2007 to present, My Company has spent a significant amount of money to advertise the mortgage broker / agent services offered under the trademark MORTGAGE SUPERHERO. [...] The marketing expenses for My Company cover a wide variety of expenses including but not limited to: digital marketing; web design, development and amendments; social media advertising such as Facebook Ads, Google Adwords; print advertising; yearly calendars; signage; graphic artist fees; community newspapers (physical and online); search engine optimization marketing with Avalanche Marketing; car wrap with the MORTGAGE SUPERHERO trademark; business cards; Mail Chimp marketing services for email marketing; Lead Pages annual subscription; Feedly Pro and Buffer subscriptions for social media interactions; LinkedIn Premium account. Although I have advertising spend [*sic*] from 2007 and 2008, related to my performance of professional services and advice to clients as a mortgage agent / broker under the trademark MORTGAGE SUPERHERO, I no longer have the numbers as I only keep my financial records for seven years.

[19] Ms. Gibbons also provides the Opponent's annual revenues for 2009-2016, totalling over \$1.6 million and, in paragraph 10 of her affidavit, states that:

[...] I can confirm that all of the revenue is related to my performance of professional services and advice to clients as a mortgage agent / broker under the trademark MORTGAGE SUPERHERO. My 2017 T4A form has yet to be issued. Although I have revenue from 2007 to 2010, related to my performance of professional services and advice to clients as a mortgage agent / broker under the trademark MORTGAGE SUPERHERO, I only have my revenue numbers from 2009 on as I no longer as I only [sic] keep my tax records for seven years. I have also only enclosed my T4 statements from 2011 to present.

[20] In the remainder of her affidavit, Ms. Gibbons addresses some issues regarding the Applicant and his application for the Mark. For example, she questions the January 1, 2006 date of first use claimed by the Applicant in his application for the Mark, because it is a national holiday in Canada, because of the high number of goods and services covered by the application and because of the later date on which the Applicant was first licensed to trade in real estate.

[21] In support of her statements, Ms. Gibbons attaches the following exhibits to her affidavit:

- Exhibit A consists of a copy of the Opponent's incorporation documentation.
- Exhibit B consists of an excerpt from the Canadian Trademarks Database regarding the registration of the Opponent's Mortgage Superhero trademark (TMA755,473).
- Exhibit C consists of a report generated by Google Analytics (which Ms. Gibbons attests provides information on visits to the Opponent's website *www.mortgagesuperhero.com*) and of a printout mentioning the award for "Best Internet Presence" nomination. I note that the Google Analytics report is undated and lacks indication of the number of Canadian visitors to the Opponent's website. In fact, this document displays no breakdown by city or by country of the number of visitors. I also note that the printout referring to the award nomination provided by Ms. Gibbons is undated and, although it contains a reference to the Opponent's trademark, it contains no reference to the Opponent.
- Exhibit D consists of printouts from the Opponent's website and of screenshots from its social media pages (both featuring its trademark), of a picture of a promotional calendar (which I note references the Opponent's website *www.mortgagesuperhero.com* and which Ms. Gibbons attests was "distributed for a number of years to [the Opponent's]

clients”), and of what appears as a copy of the graphic design proof for the Opponent’s 2007 letterhead (also featuring its trademark). Regarding the Opponent’s social media pages, I note that some of the excerpts are undated. Further, while these excerpts display the Opponent’s number of followers on each of the referenced social media platforms, I note that there is no indication of the followers’ provenance.

- Exhibit E consists of three photographs of a car, visibly registered in Ontario, (which Ms. Gibbons attests show “the trademark as used on the car wrap”) and of what appears as a copy of the graphic design proof for the Opponent’s promotional car wrap. The car wrap photographs display amongst other information the affiant’s name and phone number as well as the phrase “Your Mortgage Superhero”.
- Exhibit F consists of copies of the Opponent’s T4 statements for 2011-2016.
- Exhibit G consists of a printout from the website *www.timeanddate.com* (which Ms. Gibbons attests shows that “January 1, 2006 was on a Sunday and on New Year’s Day, and that the New Year’s Day statutory holiday was observed the following day on Monday, January 2, 2006”).
- Exhibit H consists of a copy of the results of Ms. Gibbons’ search of February 6, 2018 on the Real Estate Council of British Columbia website aiming to verify when the Applicant was licensed as a real estate professional and of her email exchange of February 7, 2018 with the same authority, confirming that the Applicant was first licensed on November 20, 2013.

The Applicant’s evidence

The Mitchell affidavit

[22] The Mitchell affidavit consists of five paragraphs and is reproduced in full below:

1. I, the undersigned, Amy I.E. Mitchell, am a brand and media designer employed by Mr. Ian Brett, the Applicant for the trade-mark REAL ESTATE SUPERHERO.

2. I hold a Bachelor of Design in Communication design from Emily Carr University and hold other certifications in the design and media industry. I have worked as a brand designer for 28 years.
3. I have created several brands for Mr. Ian Brett including REAL ESTATE SUPERHERO.
4. I confirm that all of the goods and services listed in the application is *[sic]* correct[.]
5. I confirm that the dates are correct on the REAL ESTATE SUPERHERO Application.

The Brett affidavit

[23] The Brett affidavit, for its part, provides some information about Mr. Brett's background, occupation and activities. In the first two paragraphs of his affidavit, Mr. Brett states:

I [...] am a REALTOR[®], licensed to trade real estate (License# 167101) in the province of British Columbia as of November 2013. I am a member in good standing as a licensed REALTOR[®] with The Canadian Real Estate Association (CREA) and the Real Estate Board of Great Vancouver (REBGV).

Prior to becoming a REALTOR[®], I worked in the Real Estate Industry, in the area of Marketing, Advertising, and Information Technology since 1986. I started my real estate career as the creator of the first interactive Real Estate TV channel in Canada for Western Cable Systems and subsequently for Rogers TV, where it was known as the Home Show.

[24] Regarding the Opponent's activities, in paragraph 3 of his affidavit, Mr. Brett states:

The Applicant does not dispute that the Opponent is a licensed Mortgage Broker providing services limited to that of a Mortgage Broker in the province of Ontario, and that they operate a business under the trade-mark MORGAGE *[sic]* Superhero.

[25] Disputing the remainder of the Opponent's evidence, Mr. Brett expresses his comments and opinions on the statements contained in the Gibbons affidavit. To a certain extent, the Brett affidavit is akin to a written argument. I am disregarding the portions of this document that go beyond introducing evidence, such as Mr. Brett's personal opinions on whether the parties' marks are confusing or on whether it was justifiable to carry through the present opposition proceeding. Further, while he may have work experience trading in real estate and while he may have been involved in the field of realty-based entertainment or advertising, Mr. Brett has not properly qualified himself as an expert in the real estate or mortgage industries. Therefore, I am also disregarding what he presents as his professional opinions regarding these businesses.

[26] In explaining that there are differences between the services provided by mortgage brokers and real estate agents, in paragraph 6 of his affidavit, Mr. Brett states:

[...] In point of fact, the two licenses differ from one another entirely in the services they are licensed to provide including but not limited to;

- a. The Opponent is not licensed to represent buyers and sellers in the exchange of property transactions, while the Applicant is.
- b. The Opponent claims to have built the “MORTGAGE Superhero” trademark in Canada however she is only licensed to provide those services in the province of Ontario. In contrast, the Applicant has built the “REAL ESTATE Superhero” brand and is licensed in the province of British Columbia.

[...]

[27] As part of his evidence, the Applicant also filed the following documents which Mr. Brett respectively describes as Exhibits A to H in his letter to the Registrar filing the Applicant’s evidence:

- A copy of the *Real Estate Services Act*.
- A copy of the *Mortgage Brokers Act*.
- A printout from the “Organization” page of The Canadian Real Estate Association (CREA) website.
- A printout from the Real Estate Council of British Columbia website.
- A copy of a letter dated March 25, 1988 which Mr. Brett describes as a “‘Thank You’ letter from Rogers Cable, to the Applicant” referencing his implication in the launch and development of “The Home Show”.
- A copy of an email from CREA’s legal counsel to the Applicant discussing differences between mortgage brokers and real estate professionals.
- An Internet article published on June 9, 2017 by the Ottawa Sun titled “Relationship between real estate agent, lawyer and mortgage broker”.

- An Internet article published on January 31, 2017 by “Land 1 Direct || Toronto Lands to Build and Commercial Properties” titled “Real estate agent vs mortgage broker”.

[28] I note that the above documents identified by the Applicant as Exhibits A to H are not dated or sworn as exhibits to an affidavit, nor is it indicated to which of the Applicant’s affidavits the documents might apply. The documents were simply filed with the Registrar in a loose-leaf format. Other than noting that it is unclear if the enclosures are exhibits to the Brett or to the Mitchell affidavit, I note that the Opponent has not objected to the admissibility of the documents in question. In my view, these documents identified by the Applicant as Exhibits A to H are not admissible, as they have not been properly included as exhibits to a sworn affidavit. However, even were I to treat these documents as admissible and consider them as part of the Applicant’s evidence, they would not have any impact on the outcome of the analysis of the grounds of opposition discussed below.

ANALYSIS

[29] As indicated above, the main issues to be determined are whether the application for the Mark is compliant with the pleaded provisions of the Act, whether it is registrable, whether the Applicant is the person entitled to register the Mark in Canada and whether or not the Mark is distinctive.

Section 30(b)

[30] Section 30(b) of the Act requires that there be continuous use of the Mark, in the normal course of trade, from the date claimed (January 1, 2006) to the filing date of the application (October 19, 2015) [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262]. The definition of “use” is outlined in section 4 of the Act, reproduced below:

4(1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[31] The initial burden on the Opponent is light respecting the issue of non-conformity with section 30(b) of the Act, as the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. This burden can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. The Opponent may so rely on the Applicant's evidence to meet its initial burden, if it shows that the Applicant's evidence puts into issue the claims set forth in the Applicant's application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 30-38].

[32] In its written argument, the Opponent submits that the date claimed by the Applicant "cannot possibly be correct, and that the application contains information which almost certainly is false and incorrect". First, the Opponent argues that January 1, 2006 was a Sunday as well as a statutory holiday in Canada [Gibbons affidavit, para 12, Exhibit G]. In referencing the applicable jurisprudence, the Opponent –rightly– submits as follows:

Canadian case law has repeatedly and consistently held that the reference to a date of first use of a trademark that corresponds to a statutory holiday raises a doubt about the veracity of this claim especially when there is no evidence of use of the mark on that date (see *Mexx International B.V. v. Poulin* (2004) 35 C.P.R. (4th) 241 [TMOB]; *Nerds On-Site Inc. v. Iverson* (2006) 57 C.P.R. (4th) 139 [TMOB]; *XS Energy, LLC v. Petrillo* (2007) 66 C.P.R. (4th) 43 [TMOB]). In a 2015 Trademarks Opposition Board decision (*3120490 Canada Inc. v. Murray Sales Inc.*, 2015 TMOB 89), the Board referenced the above noted decisions and stated:

‘... it has been held in previous Board decisions that the reference to a date of first use of a trademark that corresponds to a statutory holiday raises doubt as to the veracity of the claim, especially when there is no evidence of use of the mark on that date... In the present case, I am prepared to take judicial notice that the claimed date of first use, namely, July 1st, 2011, was a statutory holiday in Canada. Consequently, I am satisfied that the Opponent has discharged its initial burden with respect to the section 30(b) ground of opposition, The Applicant must therefore

establish the use of the Mark since July 1, 2011 in association with the applied for goods’.

In the present case, we submit that the Opponent has also met its evidential burden in light of the fact that the claimed date of first use is a Sunday and a holiday (New Year’s Day). [...]

[33] Second, the Opponent’s evidence suggests that the Applicant was only licensed to trade in real estate in British Columbia as of November 2013 [Gibbons affidavit, para 13, Exhibit H], which the Opponent argues is inconsistent with the Applicant’s January 1, 2006 claimed date of first use of the Mark in association with the various real estate related services contained in the application. The Applicant confirms having obtained said license in November 2013 [Brett affidavit, para 1] but submits that the Opponent’s assumption arising therefrom that “the dates on the trademark application had to line up with the date that the Applicant became a licensed Realtor [...] is untrue” [Brett affidavit, para 9].

[34] In my view, considering the long list of goods and services in the Applicant’s application, the fact that the claimed date of first use for all of the Goods and Services was a national holiday, in combination with the fact that the Applicant was not licensed as a real estate professional until well after the claimed date of first use, these facts taken together are sufficient to put into issue the Applicant’s claims of use of the Mark in association with all of the Goods and Services as of the claimed date of January 1, 2006. The Opponent having met its light initial evidential burden with respect to this ground of opposition, the onus shifts to the Applicant to demonstrate on a balance of probabilities that his application for the Mark is compliant with the provisions of section 30(b) of the Act.

[35] I note that there is no evidence of record to support the date of first use claimed in the application for the Mark (be it “since” or “since at least” January 1, 2006). The only evidence filed by the Applicant in that regard is the Mitchell affidavit. The Opponent, in its written argument, suggests that this document constitutes hearsay. Regardless, in my view, the contents of the Mitchell affidavit are not at all persuasive regarding the date of first use claimed in the application. The Mitchell affidavit is comprised solely of bald statements regarding the goods and services as well as the dates in the application for the Mark as being “correct” and Ms. Mitchell does not provide any relevant facts to substantiate her claims.

[36] Also, the Applicant has provided no evidence of use of the Mark, within the meaning of section 4 of the Act, in association with any of the Goods or Services, let alone use since or since at least January 1, 2006. There is no evidence showing if or how the Mark appears on any of the Goods or on their packaging, no indication of what constitutes the Applicant's normal course of trade and nothing to suggest that there has been any transfer of property of Goods bearing the Mark from the Applicant to Canadian consumers or that the Goods are in any way meant for export. Similarly, there is no indication if or of how the Mark is displayed in the performance and/or advertising of any of the Services.

[37] The ground of opposition based on section 30(b) of the Act is therefore successful.

Section 12(1)(d)

[38] An opponent meets its initial onus with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. In this regard, the Registrar has the discretion to check the register in order to confirm the existence of the registration relied upon by an opponent [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised the Registrar's discretion, I confirm that registration No. TMA755,473 is in good standing.

[39] The Applicant must now establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trademark.

The test for confusion

[40] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification.

[41] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: (a) the inherent distinctiveness of

the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods and services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[42] These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis. In the present case, I will therefore consider the degree of resemblance factor first.

Degree of resemblance

[43] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot* at para 20]. The preferable approach is to begin the confusion analysis by determining whether there is an aspect of each trademark that is particularly striking or unique [*Masterpiece* at para 64].

[44] In my view, the dominant element in both parties' trademarks is the term "superhero" which is more striking or unique than the descriptive terms "real estate" and "mortgage" respectively. Thus, the striking or unique aspect of both parties' marks is identical. Further, both trademarks share a similar structure, with the word "superhero" preceded by a descriptive term pertaining to the property/real estate field. In that regard, as I can take judicial notice of dictionary definitions [*Tradall SA v Devil's Martini Inc*, 2011 TMOB 65], I have referred to the Merriam-Webster Dictionary, available online at www.merriam-webster.com and note the following relevant definitions for the terms composing the marks at hand:

real estate

"property in buildings and land"

mortgage

“a conveyance of or lien against property [...]”

“//took out a mortgage in order to buy the house”

superhero

“a fictional hero having extraordinary or superhuman powers”

“an exceptionally skillful or successful person”

[45] While there are differences between the two trademarks due to the different descriptive terms that they include at the beginning, overall there is still similarity in sound and in appearance in the parties’ trademarks in view of the common presence of the more striking word “superhero”. There is also strong similarity in the ideas suggested by the parties’ trademarks. In that regard, the first components of the parties’ marks impart a similar impression as they both share a connection to property transactions. The second components of the parties’ marks are identical and therefore both trademarks convey the ideas of skill, success or of having extraordinary abilities.

[46] In sum, when considering the parties’ trademarks as a whole, I find that they bear a considerable degree of resemblance due to the shared word “superhero”, to their shared structure and to the similar connotation they convey to consumers – both suggesting a skillful professional in the general field of property/real estate. Consequently, I find that the section 6(5)(e) factor strongly favours the Opponent.

The inherent distinctiveness of the trademarks and the extent to which they have become known

[47] The trademarks at hand both possess a similarly low degree of inherent distinctiveness, as both parties’ marks are suggestive of a skilled individual operating in the property/real estate field.

[48] The strength of a trademark may be increased by it becoming known through promotion or use.

[49] As per the outline above, the Opponent has adduced evidence of use and promotion for the trademark Mortgage Superhero. In particular, the Opponent was incorporated in 2007

[Gibbons affidavit, para 1] and operates an Ontario based mortgage agent/brokerage business. Ms. Kim Gibbons is sole owner and director of the Opponent and is registered with the Financial Services Commission of Ontario, which enables her to provide various mortgage solutions in Ontario (such as residential and commercial mortgage financing and refinancing services) all such services being provided on behalf of the Opponent [Gibbons affidavit, paras 3-4]. The Opponent has revenues of over \$1.6 million associated with the Mortgage Superhero trademark for 2009-2016 and related advertising expenditures of over \$230,000 for 2009-2017 [Gibbons affidavit, paras 9-10, Exhibit F]. Amongst other marketing tools, the Opponent uses digital marketing, print advertising and promotional material [Gibbons affidavit, paras 8-9], but mainly promotes itself and the Mortgage Superhero trademark through its website at *www.mortgagesuperhero.com* and through social media platforms such as Facebook, Twitter, LinkedIn, Google Plus and YouTube [Gibbons affidavit, para 7, Exhibit D].

[50] I notice that the Opponent's evidence presents some deficiencies. For instance, it contains no indication of the specific number of Canadian visitors to the Opponent's website or of the number of Canadian followers of the Opponent's social media websites. Also, there is no mention of when and exactly how the referenced "extensive media coverage" of the brand occurred (or if/how the Canadian public was exposed to it), nor any clear indication as to how and when some of the promotional material was distributed or made available to consumers. This prevents me from concluding that the Opponent's trademark has become well-known in Canada. However, when considered in its entirety, I find that the Opponent's evidence appears consistent with its claim of use of the trademark Mortgage Superhero in Canada since August 1, 2007 in association with the mortgage services that it provides. I am satisfied (due to the revenue and advertising expenditures provided in conjunction with Ms. Gibbons' statements of fact outlined above) that the Opponent has shown that its trademark Mortgage Superhero has been used and become known at least to some extent in Canada.

[51] As per the outline above, the Applicant has not presented any evidence that his Mark has been used or become known to any extent in Canada. Consequently, I find that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trademarks, favours the Opponent.

The length of time the trademarks have been in use

[52] As discussed above, the Opponent's evidence indicates that it has been using its trademark in Canada since 2007, while the Applicant has not demonstrated any use of his Mark. Thus, the section 6(5)(b) factor also favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[53] The Opponent's evidence regarding the nature of the services it provides in association with the trademark Mortgage Superhero is generally consistent with the description of services in the Opponent's registration. As indicated above, the Opponent offers residential and commercial mortgage financing and refinancing services, including different mortgage solutions related to home purchases, investment and vacation properties and comprising the provision of property valuation information based on comparable sales in a given area. In doing so, the Opponent entertains a close working relationship with real estate lawyers, real estate agents, real estate brokers and real estate appraisers. In addition the Opponent operates a website featuring, amongst other information, articles pertaining to home purchases and renovations.

[Gibbons affidavit, paras 4, 7]

[54] The Applicant's applied for Services include, among others, the following:

[...] Appraisal of real estate; evaluation of real property; financial valuation of personal property and real estate; providing an Internet website portal offering information in the field of the purchase of new homes and condominium; real estate agencies; real estate appraisal and valuation; real estate brokerage; real estate consultancy; real estate investment services; real estate management; real estate management services; Operation of a website in the field of home renovations; real estate development; [...] Arranging and conducting real estate conferences; [...].

[55] The Opponent, referring to section 6(2) of the Act, argues that the parties' services are similar and that a finding of confusion does not require them to be identical. The Opponent further submits that there is potential overlap between the parties' channels of trade "in that they both focus on the real estate industry".

[56] The Applicant, seeking to distinguish the nature of the parties' services and businesses, essentially contends that they target different specialized markets in different geographical

locations. The Applicant's arguments are centered on the distinction between the real estate and mortgage brokerage industries and emphasize the limitations of the parties' respective professional licenses.

[57] With respect to the Services specifically pertaining to real estate listed above, while I can conceive that real estate and mortgage agents/brokers are different professionals which may possess different qualifications, knowledge or skillsets, I find that there is potential for overlap in the services that they respectively offer. Both professionals operate in intersecting fields and provide closely connected services. For instance, in the process of acquiring a piece of residential or commercial real estate, a consumer might, at the same time or in near succession, require the services of a real estate agent/broker (for instance, to assist in locating the right property and/or successfully completing the transaction) and those of a mortgage agent/broker (for instance, to assist in securing the appropriate (re)financing for the purchase). In interacting with both professionals, it seems reasonable to assume that a consumer may perceive the real estate-specific and the mortgage-specific components of the services rendered as being closely related.

[58] The Goods and the remainder of the Services are different than those of the Opponent. However, in the absence of evidence to the contrary from the Applicant, I find that they could be connected or somehow related to real estate. Further, I tend to agree with the Opponent's submission that, since the Mark itself contains the words "real estate", it could portray all of the Goods and Services as being related to real estate (especially as the Applicant's evidence indicates that he is in the real estate business). In the absence of evidence to the contrary from the Applicant, there is also no reason to conclude that the parties' goods and services would not travel through the same channels of trade and be directed to the same type of clientele.

[59] As to the Applicant's argument that the Opponent is located in Ontario, whereas the Applicant operates in British Columbia, in the context of the present opposition proceeding that is immaterial. The Opponent owns a registered trademark which provides it with exclusive rights across Canada, and the Applicant is similarly applying for registered exclusive rights across Canada. In addition, as mentioned above, the test for confusion is based on a consideration of both marks being used in the same area.

Conclusion regarding the likelihood of confusion

[60] In view of my conclusions above, particularly in view of the degree of resemblance between the trademarks and notwithstanding the differences in some of the parties' goods and services, I find that the Applicant has failed to establish, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trademark Mortgage Superhero.

[61] The ground of opposition based on section 12(1)(d) of the Act is therefore successful.

Remaining grounds of opposition

[62] As I have already found in favour of the Opponent with respect to the section 30(b) and the section 12(1)(d) grounds of opposition, I do not consider it necessary to discuss the remaining grounds of opposition under sections 16(1)(a) and 2 of the Act.

DISPOSITION

[63] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Goods

- (1) Audio tape recordings; computer games downloadable from a global computer network; computer software for database management; computer software for digital animation and special effects of images; computer software for organizing and viewing digital images and photographs; downloadable radio podcasts; DVDs containing movie recordings; e-commerce software to allow users to perform electronic business transactions via a global computer network; luminous signs; pre-recorded audiotapes; pre-recorded videotapes
- (2) Computer software that allows transmission of graphics to mobile telephones; computer software to enable the transmission of photographs to mobile telephones; music-composition software; software for creating virtual reality games; video disks and video tapes with recorded animated cartoons
- (3) Advertising leaflets; advertising pamphlets; advertising signs of cardboard; advertising signs of paper; booklets; books; cartoon strips; comic books; comic strips; comics; flyers; graphic novels; graphic prints; magazines; newsletters; newspapers; notepads; paper stationery; postcards; posters; posters made of paper
- (4) Decals; promotional decals
- (5) Casual shirts; golf shirts
- (6) Action figures and accessories; board games; educational toys; electronic action toys; interactive board games; interactive puzzles; toy action figures

Services

- (1) Advertising agency services; advice in the field of business management and marketing; database marketing services in the form of compiling customer specific databases; marketing research; production of advertising materials for others; rental of advertising space on web sites; sale of computer software
- (2) Appraisal of real estate; evaluation of real property; financial valuation of personal property and real estate; providing an Internet website portal offering information in the field of the purchase of new homes and condominium; real estate agencies; real estate appraisal and valuation; real estate brokerage; real estate consultancy; real estate investment services; real estate management; real estate management services
- (3) Operation of a website in the field of home renovations; real estate development
- (4) Broadcasting of radio and television programmes; broadcasting of radio programmes; broadcasting of radio programs; internet radio broadcasting services; mobile radio telephone services; news agency services via a global computer network; providing multiple use access to global computer information networks for the transfer and

- dissemination of a wide range of information; providing user access to a global computer network; providing user access to global computer networks; radio and television broadcasting services; radio and television programme broadcasting; radio broadcasting; radio broadcasting of information and other programs; radio program broadcasting; streaming of audio and video via the Internet featuring music, movies, news, and sports; television and radio broadcasting services
- (5) Teleconferencing and video conferencing services; video conferencing services; video streaming in the field of independent films
- (6) Printing of advertising matter for others
- (7) Arranging and conducting real estate conferences; audio and video recording services; development of radio and television news programs; development of radio programs; development of television programs; digital imaging; distribution of radio programs; distribution of television programs; distribution of television programs for others; editing of radio and television programmes; operation of a recording studio; operation of a website that provides streaming audio and video such as music, movies, television shows, music videos, news and sports webcasts; preparing audio-visual presentations; production and distribution of radio programmes; production of radio and television programmes; production of radio and television programs; production of radio programs; production of television and radio programmes; providing a website in the field of movie reviews; providing an online website comprising news, editorials, and opinions concerning current events; providing information in the field of entertainment relating to a recording artist via an online network; publication of electronic newspapers accessible via a global computer network; publication of the editorial content of sites accessible via a global computer network; radio program syndication; radio programming; recording studio services; video recording services
- (8) Film and video production; online video gaming services; post-production editing services in the field of music, videos and film; production of video games; providing ratings for television, movie, music, video and video game content; rental of entertainment media in the nature of movies and films on DVDs; video editing; video tape editing; video tape film production; videotaping
- (9) Animation design for others; building and maintaining websites; computer animation production services; computer programming and software design; computer software project management services; computer website design; consultancy in the field of software design; creating and designing web pages for others; creation, design, development and maintenance of web sites for third parties; database design and development; design and creating web sites for others; design and development of computer software; design and maintenance of web sites for others; design and testing of new products for others; design and writing of computer software; design, creation, hosting, maintenance of websites for others; design of computer database; design of homepages and websites; designing computer software for controlling self-service terminals; designing websites for the advertising purposes of others; developing computer software; graphic design; homepage and webpage design; hosting websites on the internet;

industrial and graphic art design; maintenance of websites for others; packaging design; product design consulting services; product packaging design services; updating websites for others; website design; writing and updating computer software

- (10) Licensing of advertising slogans; licensing of cartoon characters; licensing of computer software; licensing of intellectual property; on-line social networking services; online social networking services; operation of a web site that provides online social networking; registration of domain names for identification of users on a global computer network

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

PERLEY-ROBERTSON, HILL & MCDOUGALL LLP For the Opponent

No Agent Appointed For the Applicant